

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on June 12, 2007, the Examiner objected to claim 18; claims 1-4, 8-10 and 21-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fromm (US 5,435,240) in view of Skonecki (US 5,305,550), Reinhardt et al (US 4,957,787), Hirata (JP 59-016801), Roulleau (US 5,142,976), and Carroll (US 5,366,192); claims 5-7 were rejected under 35 U.S.C § 103(a) as being unpatentable over Fromm in view of Skonecki, Reinhardt, Hirata, Roulleau, and Carroll, and further in view of Lampinski (US 6,314,880); claims 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Skonecki in view of Carroll; claims 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Skonecki in view of Carroll, as applied to claim 16 above, and further in view of Lampinski.

Claim Objections

Applicant has amended claim 18 in order to ameliorate the claim objection in the pending office action. Accordingly, Applicant requests that the objections be lifted at this time.

Rejections under 35 U.S.C. § 103

In the Office Action, claims 1-4, 8-10 and 21-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fromm in view of Skonecki, Reinhardt, Hirata, Roulleau, and Carroll; claims 5-7 were rejected under 35 U.S.C § 103(a) as being unpatentable over Fromm in view of Skonecki, Reinhardt, Hirata, Roulleau, and Carroll, and further in view of Lampinski; claims 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Skonecki in

view of Carroll; claims 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Skonecki in view of Carroll, as applied to claim 16 above, and further in view of Lampinski.

Applicant thanks the Examiner for the detailed comments in the Response to Arguments section of the Office Action. In those comments, the Office Action stated that the art of record shows printing methods except for the final step of applying the image to a flower. The comments then indicate that the art of record shows that it is known to print on very delicate objects. While Applicant appreciates the Examiner's comments, Applicant respectfully disagrees with the assertion of obviousness, and respectfully submits that the cited references disclosing various articles on which printing may occur are not apt for comparison with the presently-claimed invention.

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

Section 103 specifically requires assessment of the invention “as a whole.” The Federal Circuit explained that inventions typically are new combinations of existing principles or features. *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). The Federal Circuit further explained that

[w]ithout this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. [*Ruiz* at 1275.] This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. *Id.*

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This “as a whole” assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Princeton Biochemicals Inc. v. Beckman Coulter Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Additionally, under Section 103, objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others,

licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. MPEP § 2141. To be pertinent to the issue of nonobviousness, the commercial success of devices falling within the claims of the patent must flow from the functions and advantages disclosed or inherent in the description in the specification. MPEP § 716.03(b). Also, the commercial success must be due to claimed features, and not due to unclaimed features. MPEP § 716.03(a).

Applicant does not dispute that the cited references teach pad printing methods. Applicant also does not dispute that Skonecki teaches a flower with a hand-drawn message on it. However, each of the independent claims requires either a repeatable, identical, pad-printed image on petals of live flowers, or requires the creation of a repeatable, identical, pad-printed image on petals of live flowers. Thus, more than mere pad printing and drawing on flowers is required by the claims. Applicant respectfully submits that none of the cited references teach such limitations, alone or in combination, and one of skill in the art would not find it obvious to make the presently-claimed invention by reference to the cited references.

The Office Action cites Fromm as teaching pad printing steps, then relies on Skonecki, Reinhardt, Hirata, and Roulleau as teaching that it is known and desirable to print on delicate articles such as flowers, artificial flowers, leaves of a plant, and eggs, respectively. Applicant respectfully submits that to compare and attempt to combine the cited references in the manner suggested in the Office Action fails to recognize the unique difficulties encountered when repeatedly printing an identical and repeatable image on live flowers, as is recited in the claims. Applicant has amended the claims to specifically require the printing be on live flowers, to more clearly and consistently define over what has been taught by the cited references.

Specifically, reference is made to Fromm, who specifically teaches printing on only certain types of surfaces. Specifically, Fromm teaches printing on papers, plastics, ceramics, skin, leather, fabric, and “most other solid surfaces.” (Col 5 lines 2-5) Clearly, Fromm recognizes that the pad printing disclosed therein is suitable only for certain types of surfaces, namely those surfaces that have adequate stability and support on which to receive the pressure inherent in prior pad-printing processes. None of the other cited references teach anything that would contradict the expectation of Fromm, which is consistent with the expectation of one of skill in the art at the time of Applicant’s invention, as will be made apparent below and in the appended evidence.

Specifically, the Office Action cites to Reinhardt, Hirata, and Roulleau as teaching printing on delicate surfaces. A moderately-detailed reading of these references, however, teaches nothing different than what is taught by Fromm: printing on an adequately-supported, stable, non-flexible surface. Reinhardt makes only a single mention of printing on the petals of an artificial flower at Column 1 lines 23-26, and would appear to be relevant until one of skill in the art references Figures 1, 3, and 4 of Reinhardt, which clearly show the flower petals prior to assembly into the full artificial flower. Upon referencing these Figures, one of even modest skill in the art would instantly appreciate that the printing referred to in Reinhardt occurs prior to any assembly of the flower, at the point when printing is easiest and no different than printing on paper. Similarly, while Hirata teaches printing on leaves of trees, Hirata discloses that printing only occurs after flattening and drying the leaves. (Abstract) At that point, printing on the leaves is no different than printing on any other irregularly-shaped piece of paper, and may easily be accomplished by placing the leaves on any hard, flat surface.

Rouleau teaches printing on eggs, but as would be readily appreciated by one of skill in the art, printing on the rigid, inflexible surface of the egg is much different from printing on the flexible, movable surface of a live flower. The egg-marking machine of Rouleau uses a very specialized machine to print a decoration on the exterior of an egg. (Col 1 line 61-Col 2 line 11, Col 2 line 52-Col 3 line 10, Figure 1) The complex machine of Rouleau is used to provide the repeatable image on eggs of different sizes and shapes. (Col 1 lines 58-60, Col 2 lines 24-29) Although the eggs on which Rouleau's machine prints can be considered "delicate" in one sense, Applicant's claimed invention is not for printing on a "delicate" product, but for a repeatable, identical, pad-printed image on a flower petal still attached to a live flower. The pad-printing machine of Rouleau is completely inadequate for providing such printing.

While eggs are "delicate" in that they are breakable after a certain amount of force is applied to them, one of skill in the art would also recognize that they are essentially rigid until that breaking point is reached. Therefore, a pad-printing method that appears to be adequate for eggs may be (and is) completely inadequate for flowers. Simply put, printing on a live flower petal is a completely different problem than printing on a rigid egg surface. Not only does the soft flower petal itself much more readily deform than does the rigid egg surface, but the flower petal also flexes or bends at its attachment to the flower stem while the egg surface is rigid throughout.

In recognizing the differences in rigidity between a flower petal and an egg, the problem for using the egg pad-printing machine of Rouleau for flowers then becomes readily apparent. Rouleau discloses printing using "tampography," which is disclosed as consisting "in applying a slightly convex flexible inking pad, or tampon, which has previously received the motif to be printed, to the object to be decorated." (Col 1 lines 36-39) Of course, as the "tampon" is used to

print on the outer surface of an egg, the slightly convex tampon must be deformed to a concave state as it is pressed against the surface of the egg. (See Col 1 lines 49-52 and lines 58-60) Even if the “tampon” is significantly flexible in order to provide for this deformation, some relatively large force must be applied to cause the deformation. For example, Roulleau discloses that the tampography printing process may break an already cracked egg (Col 2 lines 45-46), and for this very purpose, the machine is designed to have a conveyor with an open center to allow the broken egg contents to flow out without requiring the machine to be stopped and cleaned. (Col 2 lines 46-49, Figure 1) One of skill in the art would readily appreciate from this disclosure that the tampography process disclosed by Roulleau provides a significant force in printing on the egg.

Roulleau also discloses that the tampon used in the tampography process is applied using a very fixed and rigid mechanism, namely a “screw jack.” (Col 2 line 67-Col 3 line 4) This means that the tampon always moves back and forth through exactly the same range of motion, and this is disclosed as being necessary and advantageous so as to allow printing parts of the decoration in different colors with successive tampons. (Col 3 lines 5-7, see Figure 1) One of skill in the art, when viewing this rigid machine system of Roulleau and being aware of the force necessary to print using tampography process (that can break an already cracked egg) would never view the Roulleau system as being adequate or applicable for printing on a live flower petal still attached to the flower. Instead, one of skill in the art would again see no difference from the printing methods of Fromm: essentially, the egg presents a “solid surface” of the type in Fromm and very different from the type claimed by Applicant.

Skonecki clearly teaches providing a message on a flower. However, nothing in Skonecki teaches the claimed invention that requires a repeatable, identical, pad-printed image,

and nothing in Skonecki teaches anything that would lead one of skill in the art to understand that pad-printing methods such as taught in Fromm could be adapted to printing on flowers. The Office Action indicates that one of skill in the art would look to other applicators other than the pen or brush disclosed in Skonecki for applying messages or drawings to flowers. Applicant respectfully disagrees in light of the evidence submitted herewith and the differences between the pad-printing methods in the references of record. The very hand-written nature of the message of Skonecki (See Claim 1 of Skonecki.) prevents achieving the claimed repeatable, identical, pad-printed image. Again, Applicant reiterates that nothing in the cited references implies that pad-printing on solid surfaces could be adapted to printing on fresh flowers.

Carroll simply teaches a flower holder with a separate location for a card. (Entire reference) Nothing in Carroll provides any teaching that would suggest that it is possible to adapt a pad-printing method to printing on live flowers.

Therefore, Applicant respectfully submits that the cited references fail to make the claims contained herein obvious.

Additional Evidence and Indicia of Non-Obviousness

In light of the above arguments, Applicant wishes the Examiner to consider additional indicia of non-obviousness that was previously submitted in the parent case, Serial No. 09/964,989, of which the present case is a divisional application. As the benefits and evidence set forth in the attached Declarations relate to the claimed and disclosed features of the present application, Applicant respectfully submits that the evidence from the parent case is applicable to the consideration of non-obviousness in the present case. Applicant therefore respectfully

submits the attached evidence for the Examiner's consideration in conjunction with the arguments made previously and below.

Applicant believes that the evidence submitted herein shows that persons skilled in the art did not find the claimed invention obvious even many years after the effective dates of the cited references. Therefore, Applicant maintains that one of skill in the art would not find the claimed invention obvious and would not expect success in combining the references in the manner suggested by the Office Action.

Applicant's position is amply documented and supported by the evidence and indicia of non-obviousness submitted herewith. Attached are declarations from various persons regarding the claimed invention, as follows:

Declaration dated September 22, 2003 by Blaine Harris, then-president of the assignee of the present application;

Declaration dated May 27, 2004 by Chris Osburn, owner of a licensee of the claimed invention;

Declaration dated June 1, 2004 by Candice Harris, director of a licensee of the claimed invention;

Declaration dated May 25, 2004 by Gary E. Doran, president of a licensee of the claimed invention; and

Declaration dated May 21, 2004 by George Barquin, vice-president of a licensee of the claimed invention.

The information contained in the attached declarations provides objective indicia of the fact that the claimed invention was generally and widely considered non-obvious in 2003-2004, approximately ten years or more after the issuance of the majority of the patents relied on by the Examiner in the current rejections. In light of this objective evidence of non-obviousness, as detailed below, Applicant respectfully requests that the Examiner reconsider the rejections.

Applicant has had considerable commercial success and success in finding partners for licensing agreements. The considerable success in finding partners for licensing agreements shows the commercial success of embodiments of the present invention flows from the functions and advantages disclosed in the description in the specification and that the commercial success is due to the claimed features, otherwise, licensing agreements would not be necessary. The following are examples of this success and are supported by the attached declarations.

Licensing

In 2003, Applicant had entered into licensing agreements with Taylor Corporation, the largest wedding card printing company in the nation with over 87% of the nation's wedding card printing business. Applicant had also licensed its product to GiftTree (gifttree.com), a large corporate and public web site. FTD.com had also licensed, featured, and sold Applicant's product. USA Bouquet, based in Miami, Florida had also licensed Applicant's product. Chicago-based Kennecott Brothers had also licensed Applicant's product. Kennecott Brothers, servicing 1800 retail outlets, had licensed Applicant's equipment, both the printers and the engravers. In addition, Applicant had licensed over 80 individual retail shops around the nation with the capacity to print flowers on their own premises. Other Licensees included Sam's Club,

Publix (850 retail outlets), and others. (See Declaration of Blaine Harris, as supported by the other signed declarations of four licensees.)

Applicant's considerable success in finding partners for licensing agreements shows incredible commercial success. This success in licensing shows is clearly related to the disclosed and claimed invention, as is clear from the attached declarations of the licensees. (See Declarations of George Barquin, Gary Doran, Candice Harris, and Chris Osburn.)

Commercial Success

As set forth in the declaration of Blaine Harris, Applicant's licensing agreement with FTD.com generated sales of approximately seventy dozen flowers a day in 2003. Other participants in Applicant's sales network in 2003 included Taylor Corporation; Giftfree.com; USA Bouquet; Kennecott Brother's 1800 retail establishments and its large Super Floral groups including Jewel Osco/Albertsons; 80 individual retail shops; Sam's Club; Publix's 850 retail outlets; Golden Rose in Canada; the Zuriel group in Holland and Europe; wholesalers in the United States, including Delaware Valley in the Northeast, Denver Floral Wholesale in the Northwest and through Colorado, and Mellano in Southern California and Nevada; and other individual planners of large corporate events and weddings. (See Declaration of Blaine Harris.)

Applicant's considerable success in establishing its extensive sales and marketing network by finding partners for licensing agreements shows the commercial success of embodiments of the present invention, and show that such success flows from the functions and advantages disclosed in the description in the specification and claimed in the appended claims. (See Declarations of George Barquin, Gary Doran, Candice Harris, and Chris Osburn.)

Long-Felt Need

The present invention also solves the long-felt need for a repeatable, rapid method for laying a design onto a flower that preserves the integrity of the flower. Evidence of this long-felt need is found in Skonecki, which documents this need dating back to 1993. See Skonecki, Column 2, lines 16-18. Applicant's success in licensing its product further shows this long-felt need was not solved by Skonecki and shows that Applicant's product solves this long-felt need. (See Declaration of Blaine Harris.) The licensees of Applicant's claimed invention have specifically attested and further demonstrated that a long-felt need has existed that is addressed by Applicant's claimed invention. (See Declarations of George Barquin, Gary Doran, Candice Harris, and Chris Osburn.)

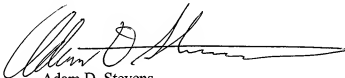
Therefore, in light of the comments above and the attached evidence, Applicant respectfully submits that the claimed invention is not made obvious by the cited combination of references. Applicant therefore respectfully requests that the Examiner reconsider the rejections in light of the above and attached information, and promptly allow the application.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 12 day of October, 2007.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Adam D. Stevens', with a long horizontal flourish extending to the right.

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